

REMARKS

Upon entry of this Amendment A, claims 1-89, 91-119, 122-124, 127-133, 137-141, 144, and 146-175 are pending and under consideration. Claims 90, 120, 121, 125, 126, 134-136, 142, 143 and 145 were cancelled. Applicant expressly reserve the right to pursue these cancelled claims in one or more continuation applications.

Taxanes having a C10 ester moiety and a C3' C₃₋₅ alkyl or alkenyl moiety are disclosed in WO 96/13495 (Ojima), reference no. 44 in the IDS submitted on January 22, 2004. In addition, taxanes having a C10 ester moiety and a C3' C₃₋₅ alkyl or alkenyl moiety or trifluoromethyl group are disclosed in WO 97/32578 (Ojima), reference no. 46 in the IDS submitted on January 22, 2004. Neither of these disclosures, however, suggest the claimed taxanes, as amended herein, wherein X₃ is heterocyclo. This amendment is supported, for example, by 135 of the exemplified compounds and in the specification at page 4, lines 24-29 and page 6, lines 23-24. The dependent claims were amended accordingly. Claim 91 was also amended to cancel the "substituted or unsubstituted" language as redundant. As noted in the definition of "heterocyclo" at page 21 of the specification, the term "heterocyclo" itself includes optionally substituted heterocyclic moieties.

In addition to the claim amendments, claims 165-175 have been added by this amendment. No new subject matter has been added by these new claims. Claim 165 is supported, for example, by the definition of "heterocyclo" at page 21 of the specification. Claims 166 and 167 are supported, for example, by the definitions of "heterocyclo" and "heteroatomic" at page 21 of the specification. Claims 168-170 are supported, for example, at page 4, lines 6-23 of the specification. Likewise, claims 171 and 172 are supported, for example, at page 3, lines 19-22 of the specification. Claim 173 is supported, for example, by the definition of R₁₄ for structure (1) at pages 2-3 of the specification. Claim 174 is supported, for example, by the claims as originally filed and at page 4, lines 6-9 of the specification. Claim 175 is supported by compound number 3102 at page 31, line 19 of the specification.

Reconsideration is respectfully requested of the rejection of claims 1-164 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

- * claims 1-12 of U.S. Patent No. 6,649,632. In response, enclosed is a terminal disclaimer to obviate this rejection.

Reconsideration is also requested of the rejection of claims 1-164 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,780,879. The present claims are directed to taxanes having a C10 ester substituent. The '879 patent, however, is directed to C7 carbonate-substituted taxanes having a hydroxyl group at the C10 position. There is no motivation that would lead a person skilled in the art to modify the C7-carbonate-C10-hydroxy taxanes of the '879 patent to synthesize the C7-hydroxy-C10-ester substituted taxanes of the present invention. In fact, the Office confirms that a clear demarcation exists in paragraph 6 of the "Certain Observations" section of the Office action.

CONCLUSION

In light of the foregoing, applicants request entry of the claims, withdrawal of all claim rejections, and solicit an allowance of the claims. The Examiner is invited to contact the undersigned attorney should any issue remain unresolved.

The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

Respectfully submitted,

/Bradley S. Schammel/

Bradley S. Schammel, Reg. No. 54,667
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

BSS/vlm
*Enclosure

VIA EFS